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10/597,397

07/24/2006

Makoto Tomioka

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EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

MAIL DATE

DELIVERY MODE

08/21/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/597,397 | <b>Applicant(s)</b><br>TOMIOKA, MAKOTO |  |
|                              | <b>Examiner</b><br>Thong Nguyen      | <b>Art Unit</b><br>2872                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/24/06 &amp; 8/11/06</u> .                                   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Pre-Amendment***

1. The present Office action is made in response to the Pre-amendments filed on 7/24/06 and 7/28/06. It is noted that in the pre-amendment of 7/24/06, applicant has made changes to the abstract and the claims, and in the pre-amendment of 7/28/06, applicant has filed a substitute specification with a marked-up copy showing the changes to the specification and a statement that the substitute specification does not contain any new matter. Regarding to the claims, applicant has amended claims 1-4. There is not any claim being added or canceled from the application.

### ***Oath/Declaration***

2. It is noted that while the oath or declaration does not provide the residence and the mailing address of the inventor; however, such information are provided in the Application Data Sheet filed by applicant on 7/24/06.

### ***Drawings***

3. The drawings contained one sheet of figures 1-3 were received on 7/24/06. These drawings are approved by the examiner.

### ***Specification***

4. A substitute specification without claims filed by applicant on 7/28/06 has been received by the Office and approved by the examiner.

5. The lengthy specification which was amended by the amendment of 7/28/06 has not been checked to the extent necessary to determine the presence of all possible

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minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

6. The disclosure is objected to because of the following informalities: a) Paragraph [0001], on line 1, the terms thereof "Rigid endoscopes usually have an optical system" has a grammatical error. Should the mentioned terms be changed to --Each of a rigid endoscope usually has an optical system-- or any other suitable terms to correct the grammatical error in the mentioned terms? b) Paragraph [0007], on line 6, "unit" should be changed to --units--. There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi (U.S. Patent No. 4,693,568).

Takahashi discloses a relay system for use in a rigid endoscope. The endoscope as described in column 1 and shown in fig. 13 comprises an objective lens system (2), an eyepiece system (4) and a plurality of relay lens units (3, 3') disposed between the objective lens system and the eyepiece system.

Regarding to the structure of the relay lens unit, in columns 3-5 and in fig. 2,

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Takahashi discloses a plurality of relay lens units. In the first embodiment as provided in columns 3-4 and shown in fig. 2, the relay lens unit which comprises the following features: a) two half sets arranged symmetrically with respect to each other about a center of the whole relay lens unit; b) each half set comprises a triplet having a first positive lens (20) having lens surfaces (r1, r2), a negative lens (22) having lens surfaces (r3, r4); and a positive lens having lens surfaces (r4, r5); c) The negative lens (22) having a concave entrance lens surface (r3) facing the direction of incident light and a planar exit surface (r4), and has a sufficient power to compensate for the aberrations caused by the field of curvature of other relay set; d) the positive lens having lens surfaces (r4, r5) has a planar entrance surface (r4) and a convex exit surface (r5); and e) the negative lens (22) and the positive lens having lens surfaces (r4, r5) forms a cemented doublet in which the planar exit lens surface (r4) of the negative lens (22) and the planar entrance surface (r4) of the positive lens having lens surfaces (r4, r5) are bonded together..

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. The U.S. Patent Nos. 5,888,193 and 7,002,741 are cited as of interest in that it discloses a relay lens system having a plurality of relay lens units disposed between an objective lens system and an eyepiece system of a rigid endoscope wherein each relay lens unit comprises two halves which each half comprises a triplet of a first positive lens

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in the form of a plano-convex and a cemented lens defined by a negative lens and a second positive lens which second positive lens is in the form of a biconvex or a plano-convex. See Patent No. 5,888, 193, columns 3-4 and fig. 3 or Patent No. 7,002,741, columns 5-6 and fig. 5.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thong Nguyen/  
Primary Examiner, Art Unit 2872

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